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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/710,430	11/09/2000	Shuji Hanada	11151/5	5650

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EXAMINER

WILKINS III, HARRY D

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 07/18/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/710,430

Applicant(s)

HANADA ET AL.

Examiner

Harry D Wilkins, III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 8-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 8-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-4 and 8-16 are pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 23 May 2002 has been entered.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 9-11 and 16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Araya et al (JP 10-219375 A).

These claims are rejected for the same reasons as stated in paragraph no. 6 of paper no. 5.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Araya et al (JP 10-219375 A) as applied to claim 1 above, and further in view of Farzon-Nia et al (US 5,429,504).

Claim 8 is rejected for the same reasons as stated in paragraph no. 8 of paper no. 5.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Araya et al (JP 10-219375 A) as applied to claim 1 above, and further in view of Beyar et al (US 6,127,597).

Claim 12 is rejected for the same reasons as stated in paragraph no. 9 of paper no. 5.

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Araya et al (JP 10-219375 A) as applied to claim 1 above, and further in view of Regan (US 4,795,458).

Claim 13 is rejected for the same reasons as stated in paragraph no. 10 of paper no. 5.

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Araya et al (JP 10-219375 A) as applied to claim 1 above, and further in view of Kizelshteyn et al (US 5,215,105).

Claim 14 is rejected for the same reasons as stated in paragraph no. 11 of paper no. 5.

10. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Araya et al (JP 10-219375 A) as applied to claim 1 above, and further in view of Besselink et al (US 5,551,871).

Claim 15 is rejected for the same reasons as stated in paragraph no. 12 of paper no. 5.

Response to Arguments

11. Applicant's arguments filed 23 May 2002 have been fully considered but they are not persuasive. Applicant has argued that:

- a. Araya et al do not teach an overlapping composition for Sn;
- b. the discovery relating to the effect of Sn on the superelasticity is novel and unobvious;
- c. even if there is an overlap of ranges, it can not necessarily be concluded that in every instance the composition of Araya et al behaves with the same elasticity and shape memory as that claimed by Applicants.

In response to Applicant's first argument, the argument is based on the inventive range of composition being 3-6 at% Sn. However, the Examiner would like to point out that the claimed range is actually 2-6 at% (see claim 4). Thus, the composition disclosed by Araya et al anticipates the claimed ranges.

In response to Applicant's second argument, though the effect of Sn on the superelasticity properties had not been discovered previously, the composition of Araya et al anticipates the claimed composition.

In response to Applicant's third argument, though the alloy composition disclosed by Araya et al would not have the claimed properties in every instance, one composition disclosed by Araya et al would have the claimed properties. Thus, the single composition disclosed by Araya et al that is within the claimed range of composition anticipates the claimed invention.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry D Wilkins, III whose telephone number is 703-305-9927. The examiner can normally be reached on M-F 7:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy V King can be reached on 703-308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Harry D Wilkins, III
Examiner
Art Unit 1742

hdw
July 8, 2002


ROY KING
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700